

REMARKS/ARGUMENTS

The Office Action mailed June 13, 2005 has been carefully considered. Reconsideration in view of the following remarks is respectfully requested.

In view of the Examiner's earlier restriction requirement, Applicant retains the right to present claims 30-44 in a divisional Application.

With this amendment it is respectfully submitted the claims satisfy the statutory requirements.

The First 35 U.S.C. § 103 Rejection

Claims 1, 2, 5, 13, 21, 25, 26, 45, 49, 51, 53-56, 58-61 and 63-71 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Perkins¹ in view of Inoue et al.², among which claims 1, 21, 26 and 45 are independent claims. This rejection is respectfully traversed.

According to the Manual of Patent Examining Procedure (M.P.E.P.),

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure.³

¹ U.S. Patent No. 5,159,592

² U.S. Patent No. 6,891,819

³ M.P.E.P. § 2143.

Specifically, the Office Action contends that the elements of the presently claimed invention are disclosed in Perkins except that Perkins does not teach that the home domain does not contain any IP addresses in common with said domain associated with said NAS.⁴ The Office Action further contends that Inoue teaches a home domain containing no IP addresses in common with the domain associated with the NAS and that it would be obvious to one having ordinary skill in the art at the time of the invention to incorporate Inoue into Perkins in order to allow the system of Perkins to be compatible with other networks, thereby increasing the range of the system as well as the customer base of which it can service, as well as authenticating an individual user who is operating the mobile computer when the mobile computer is connected to a visited site network and transmits a current location registration message to the home agent as supported by '819. The Applicant respectfully disagree for the reasons set forth below.

Applicant respectfully submits that any invention resulting from the combination of Perkins and Inoue would not be analogous to the presently claimed invention. Rather, at best, it would be analogous to the prior art described in the background section of the present application on page 2, lines 17-21. Namely, it would teach a system where IP address requests are tunneled from the NAS to the HGS.

Perkins does not describe the tunneling of IP address packets for the simple reason that such tunneling is not necessary when Perkins is taken alone. As described in previous amendments, Perkins does not teach sending an IP address request to a distinct domain from the domain of the NAS - all requests in Perkins may be handled within the same domain. As such, there is no need in Perkins to tunnel between domains to service the request.

⁴ Office Action ¶ #2.

In Inoue, despite the fact that there are distinct home networks and other section networks, there is no transmission of IP address requests between the networks. As stated in Col. 7, lines 31-40:

When the mobile computer 2 moves outside its own home network, the mobile computer 2 acquires an address to be used at a visited site network using a protocol such as DHCP (Dynamic Host Configuration Protocol) or PPP (Point-to-Point Protocol) at the visited site network (1b in this example). When the address is acquired, the mobile computer 2 transmits a registration message containing a current location information to the home agent 5 in the home network 1a.

Thus, the invention in Inoue obtains an IP address locally and only contacts the home network after the IP address has been obtained. There is no specific disclosure of whether or not a tunneling protocol is utilized for this inter-network communication, however Inoue builds upon IP (RFC 2002) (see Col. 6, line 66 through Col. 7, line 1 - "The communication system of FIG. 1 is assumed to be supporting communications of a mobile computer according to the mobile IP (RFC 2002). Applicant has provided a copy of IP RFC 2002 along with this response for the Examiner's convenience, but it clearly describes the use of a tunneling protocol on datagrams transmitted between networks.

Applicant therefore respectfully submits that the combination of Perkins and Inoue would not teach or suggest "an IP address requester for requesting an IP address from the HGS, on behalf of a user without using a tunneling protocol" as claimed in claim 1.

Applicant also respectfully maintains that the combination of these references is improper as both teach away from the claimed invention. Namely, both references clearly teach inventions where an IP address request is handled intra-domain. Neither of these suggest the transmission

of these IP address requests outside of the domain in which the user is currently connected. Perkins limitations in this manner were discussed in previous amendments. In Inoue, inter-domain communication is clearly described as the registration message is sent to the home agent. Yet, Inoue specifically excludes the IP address request from this communication, preferring to handle it intra-domain. If the Applicant in Inoue was therefore clearly aware of the possibility of sending communications inter-domain to a home domain, yet specifically taught away from such communications with respect to IP address requests. Applicant therefore respectfully submits that it is improper to now attempt to modify the reference such that it now teaches inter-domain communications of IP address requests.

As such, Applicant respectfully submits that independent claim 1 is now in condition for allowance.

As to independent claims 21, 26, and 45, these claims contain elements similar to that as described above with respect to claim 1, and thus Applicant respectfully submits that these claims are now also in condition for allowance.

As to claims 25 and 49, please note that these claims were canceled in a previous amendment.

As to dependent claims 2, 5, 13, 51, 53-56, 58-61, and 63-71, the argument set forth above is equally applicable here. The base claims being allowable, the dependent claims must also be allowable.

The Second 35 U.S.C. § 103 Rejection

Claims 3, 9, 23, 28, 47, 57 and 62 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Perkins in view of '819 in view of Holt et al.⁵. This rejection is respectfully traversed.

As to dependent claims 3, 9, 23, 28, 47, 57 and 62, the argument set forth above is equally applicable here. The base claims being allowable, the dependent claims must also be allowable.

The Third 35 U.S.C. § 103 Rejection

Claims 4, 24 and 48 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Perkins in view of '819 in view of Holt et al., as applied to the claims listed above, and further in view of Inuoe et al.⁶. This rejection is respectfully traversed.

As to dependent claims 4, 24 and 48, the argument set forth above is equally applicable here. The base claims being allowable, the dependent claims must also be allowable.

The Fourth 35 U.S.C. § 103 Rejection

Claims 22, 27, 46 and 50 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Perkins in view of '819 in view of Holt et al. as applied to the claims above, and further in view of Reid et al.⁷. This rejection is respectfully traversed.

⁵ U.S. Patent No. 6,070,192

⁶ U.S. Patent No. 6,442,616

⁷ U.S. Patent No. 6,233,616

As to dependent claims 22, 27, 46 and 50, the argument set forth above is equally applicable here. The base claims being allowable, the dependent claims must also be allowable.

In view of the foregoing, it is respectfully asserted that the claims are now in condition for allowance.

Conclusion

It is believed that this Amendment places the above-identified patent application into condition for allowance. Early favorable consideration of this Amendment is earnestly solicited.

If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the number indicated below.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case. Please charge any additional required fee or credit any overpayment not otherwise paid or credited to our deposit account No. 50-1698.

Respectfully submitted,

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